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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/255,222	02/22/1999	MICHAEL S. WILLIAMS	P2160/170178	8140

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EXAMINER

HRUSKOCI, PETER A

ART UNIT

PAPER NUMBER

1724

DATE MAILED: 05/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/255,222

Applicant(s)

WILLIAMS ET AL.

Examiner

Peter A. Hruskoci

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 7-11 and 36 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Sargent et al. 5,234,466. Sargent et al. disclose (see col. 1 lines 54-61 and col. 3 lines 4-13) a method for adjusting the pH of a process stream or solution of a papermaking process substantially as claimed. The claims differ from Sargent et al. by reciting that the process stream is not a bleaching solution, and includes a group of process streams excluding a bleaching solution. It is submitted that the disclosure of Sargent et al. does not appear to be limited to bleaching solutions, and appears to include the treatment of any process stream where acid has been traditionally used. It would have been obvious to one skilled in the art to modify the method of Sargent et al. by adding urea sulfate to the recited process streams, to aid in adjusting the pH of the process streams.

3. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindstrom et al. in view of Sargent et al. 5,234,466.. Lindstrom et al. (see col. 1 line 55 through col. 2 line 60) disclose that it is known in the art to regulate the pH value of a

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papermaking process solution with aluminum sulfate. The claims differ from Lindstrom et al. by reciting the addition of urea sulfate. Sargent et al. disclose (see col. 1 lines 54-61 and col. 3 lines 4-13) that it is known in the art to decrease the amount of acid required by a papermaking process, or adjust the pH of a process stream or solution of a papermaking process stream by the addition of urea sulfate. It would have been obvious to one skilled in the art to modify the method of Lindstrom et al. by addition of urea sulfate in view of the teachings of Sargent et al., to aid in adjusting the pH of the stream or solution.

4. Applicants argue that if Sargent et al. is not limited to bleaching solutions and includes the treatment of any process stream where acid has been traditionally used, as alleged by the Examiner, then this application should be entitled to benefit of the filing date of Sargent et al. by virtue of its priority claim. It is submitted that the subject matter recited in claims 7-11 and 36 are not entitled to the filing date of Sargent et al. because these claims recite new subject matter such as "pulping or papermaking process", "proviso...not a bleaching solution", and "process stream or solution is selected...effluent stream" which appears to have no clear antecedent basis in the specification of the Sargent et al. patent.

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5. Applicants argue that if applicants are not entitled to the benefit of the priority claim to Sargent et al., then the Examiner should admit that the teachings in Sargent et al. are not sufficient to reject the claims over the Sargent et al. reference alone. It is submitted that the process streams or solutions recited in the instant claims are not specifically disclosed in the Sargent et al., and are not entitled to the priority claim for reasons stated above. However, the teachings of Sargent et al. are considered sufficient to reject the claims under 35 U.S.C. 103 (a) because it would have been obvious to one skilled in the art having the teachings of Sargent et al. before him, to modify the method of Sargent et al. by adding urea sulfate to the recited process streams, to aid in adjusting the pH of the process streams. Furthermore, applicants have not presented sufficient factual evidence to support the above argument.

6. Applicants argue that there is no motivation to combine Lindstrom which discloses the use of alum in a papermaking process, and Sargent et al. which discloses the use of urea sulfate in textile processing. It is noted that Lindstrom discloses that aluminum sulfate is traditionally added to paper production stocks or streams to improve filler retention and regulate pH values. It is further noted that Sargent et al. is not limited to textile processing and includes motivation for adjusting the pH of paper manufacturing streams with urea sulfate to reduce corrosion on metal equipment. It would have been

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obvious to one skilled in the art having the references before him, to modify the method of Lindstrom by addition of urea sulfate in view of the teachings of Sargent et al., to aid in regulating the pH of the papermaking streams, absent a sufficient showing of unexpected results..

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter A. Hruskoci whose telephone number is (703) 308-3839. The examiner can normally be reached on Monday through Friday from 6:30 AM to 4:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. David Simmons, can be reached on (703) 308-1972. The fax phone number for this Group is (703) 872-9310 (non-after finals) and 703-872-9311 after finals.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.


Peter A. Hruskoci
Primary Examiner
Art Unit 1724

P. Hruskoci
May 14, 2003